

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ZHAO, Wen; CHAUDRY, Shahid, R.; PLESTID, T., L., Trevor; XUE, Hao;
YEUNG, Grace, T., Y.; YANOSHEWSKI, Clifford, W.
Serial No.: 10/533,960
Filed: May 4, 2005
Title: METHOD AND SYSTEM FOR MAINTAINING A WIRELESS DATA
CONNECTION
Group: 2617
Examiner: LY, NGHI H.
Attorney Ref.: PAT 799W-2 US

October 11, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop AF

PRE-APPEAL BRIEF REQUEST FOR REVIEW

We submit that this case is appropriate for the pre-appeal process as the Final Action, which is a new ground of rejection, clearly fails to demonstrate a *prima facie* case of obviousness for any of the pending claims, there are clear errors in the rejections, and the rejections omit essential elements for a *prima facie* rejection.

Clear errors suitable for a pre-appeal review include:

- 1) lack of *prima facie* case for rejecting claim 12;
- 2) clear error in designating the Office Action of May 8, 2007 as FINAL

1) Lack of *prima facie* case for rejecting claim 12

In our response to the Final Action, at pages 2-5, we presented arguments indicating that Hunzinger does not teach or suggest all the claimed limitations; that there is no teaching or suggestion in Hunzinger to modify its teachings to arrive at the claimed invention; and that, even if Hunzinger were modified, there would be no reasonable expectation of success and such modification would not result in the invention as claimed herein. We direct the pre-appeal panel to those arguments, which we believe should be convincing on their own.

In order to demonstrate that the rejection is clearly deficient, we reproduce column 2, lines 22-29 of Hunzinger, which the Examiner has quoted, in support of his rejection, at pages 2 and 3 of the Office Action dated May 8, 2007:

Another aspect of the present invention is a timer setting circuit for use in a mobile communication system. The timer setting circuit comprises a reconnection

timer and a timer setting circuit. The timer setting circuit sets the reconnection timer to a value after a failed connection attempt between a mobile station and the mobile communication system. The timer setting circuit determines the value of the reconnection timer is based on a set of data regarding connection requests[emphasis added].

Accordingly, at a very basic level, this excerpt teaches that the reconnection timer of Hunzinger is a timer having a time value set by a timer setting circuit after a failed connection attempt. In addition, we respectfully direct the pre-appeal panel to the operation of the reconnection timer described at least at Fig. 2 and its related text at column 4, lines 8-27 of Hunzinger. No connection has been previously established, as recited in pending claim 12.

Even if we were to ignore the details of the claim 12, Hunzinger simply does not teach or suggest the step of *determining, at minimum fixed time intervals determined by a service check timer, the status of a previously established data connection.*

In order to try and force a rejection based on the Hunzinger reference, the examiner considers the terms “failed”, “was” and/or “unsuccessful” to read on “a previously established data connection” (see page 2 of Advisory action dated July 31, 2007). Contrast this with the Examiner’s admission that “Hunzinger does not specifically disclose re-establishing the previous established data connection if the transmitted connection request is accepted by the wireless data network” (see page 3, paragraph 2 of Office Action dated May 8, 2007). Hunzinger fails to teach or suggest the step of “re-establishing the previous established data connection” simply because Hunzinger is not concerned with checking the status of a previously established data connection, as claimed. The rejection is therefore clearly erroneous. We re-iterate our arguments in our response to the Final Action, at pages 2-5, which explains in more detail not only how the claims differ from what is taught by Hunzinger, but also why the rejection is erroneous.

Furthermore, Thornton fails to teach or suggest determining the status of previously established data connection. Thornton discloses a system and method used by a mobile device to switch between a data connection and a voice connection to allow sampling of audio recordings when using the mobile device to shop for audio product. Thornton is not concerned with monitoring the status of a previously established data connection and does not teach or suggest any type of timer for determining the status of any type connection. Neither Hunzinger nor Thornton address the problem solved by the present invention as claimed, the problem being that of losing a connection between a mobile device and a wireless network and maintaining a “always-on” data connection on a wireless data network.

2) Clear error in designating the Office Action of May 8, 2007 as FINAL

In the Office Action dated November 17, 2006, which immediately preceded the Office Action of May 8, 2007, the Examiner stated that “the features upon which applicant relies (i.e., “*for reestablishing a connection if the connection is lost subsequent to initial connection*”) are not recited in the rejected claims” (see page 9 of the November 17, 2006 Action). Subsequently, in the response filed on February 19, 2007, Applicant amended the claims to clearly and distinctly define the subject matter by reciting in claim 12, among others, “re-establishing the previously established data connection if the transmitted connection request is accepted by the wireless data network” (emphasis added).

As stated earlier in this submission, the Examiner conceded that “Hunzinger does not specifically disclose re-establishing the previous established data connection if the transmitted connection request is accepted by the wireless data network” (see page 3, paragraph 2 of Office Action dated May 8, 2007). However, the Examiner proceeded to reject claims 2-6, 9, 10, 12-16, 18, and 21-27 as being obvious over Hunzinger in view of Thronton. Furthermore, the Examiner designated the Action as being FINAL although the amendments submitted by the Applicant were purposed to clarify the nature of the “previously” established connection. Applicant submits that this amendment did not necessitate the new ground(s) for rejection as contended by the Examiner. Therefore, there is a clear error on the part of the Examiner in designating the Office Action of May 8, 2007 as FINAL.

A Petition for a Three-Month Extension of Time is enclosed under separate cover. Applicant authorizes the Commissioner to debit any required fee from Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP. The Commissioner is further authorized to debit any additional amount required, and to credit any overpayment to the above-noted deposit account.

Respectfully submitted,
Wen ZHAO, et al.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

PAT 799W-2

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Signature _____

Typed or printed name _____

Application Number

10/533,960

Filed

May 4, 2005

First Named Inventor

Wen ZHAO et al.

Art Unit

2617

Examiner

Nghi H LY

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Anne Kinsman/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

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☐ attorney or agent acting under 37 CFR 1.34.

October 11, 2007

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

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